

the description of the nature of the collective membership organization in the statement of use must conform to that specified in the notice of allowance; and

(v) For a collective mark and certification mark, the applicant is exercising legitimate control over the use in commerce of the mark;

(2) One specimen showing how the applicant, member, or authorized user uses the mark in commerce. See § 2.56 for the requirements for specimens;

(3) *Fee(s)*. The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the statement of use, or the application will be abandoned. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining class(es) or to specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class, in ascending order. The Office will delete the class(es) not covered by the fees submitted;

(4) For a collective mark, the requirements of § 2.44(a)(4)(i)(A);

(5) For a certification mark, the requirements of § 2.45(a)(4)(i)(A) through (C); and

(6) The title "Statement of Use" should appear at the top of the first page of the document, if not filed through TEAS.

(c) *Minimum filing requirements for a timely filed statement of use*. The Office will review a timely filed statement of use to determine whether it meets the following minimum requirements:

(1) The fee required by § 2.6 for at least one class;

(2) One specimen of the mark as used in commerce; and

(3) The verified statement in paragraph (b)(1)(ii) of this section. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement on or before the statutory deadline for filing the statement of use.

(d) *Deficiency notification*. If the statement of use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (c) of this section, the Office will notify the applicant of the deficiency. If the time permitted for the applicant to file a statement of use has not expired, the applicant may correct the deficiency.

(e) *Notification of refusals and requirements*.

A timely filed statement of use that meets the minimum requirements specified in paragraph (c) of this section will be examined in accordance with §§ 2.61 through 2.69. If, as a result of the examination of the statement of use, the applicant is found not entitled to registration, the applicant will be notified and advised of the reasons and of any formal requirements or refusals. The statement of use may be amended in accordance with §§ 2.59 and 2.71 through 2.75.

(f) *Statement of use may not be withdrawn*. The applicant may not withdraw a timely filed statement of use to return to the previous status of awaiting submission of a statement of use, regardless of whether it is in compliance with paragraph (c) of this section.

(g) *Verification not filed within reasonable time*. If the verified statements in paragraphs (b)(1)(ii) and, if applicable, (b)(1)(v) of this section are not filed within a reasonable time after they are signed, the Office may require the applicant to submit substitute verified statements attesting that the mark is in use in commerce, and, if applicable, the applicant is exercising legitimate control over the use of the mark in commerce.

(h) *Amending the application*. The statement of use may include amendments in accordance with §§ 2.51, 2.59, and 2.71 through 2.75.

(i) *Concurrent use*. If the application is amended to concurrent use under § 2.73, the statement of use must include a verified statement modified in accordance with § 2.33(f), § 2.44(d), or § 2.45(d).

(j) *Multiple-class application*. For the requirements of a multiple-class application, see § 2.86.

(k) *Abandonment*. The failure to timely file a statement of use which meets the minimum requirements specified in paragraph (c) of this section shall result in the abandonment of the application.

## **§ 2.89 Extensions of time for filing a statement of use.**

(a) The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the date of issuance of the notice of allowance under section 13(b)(2) of the Act and must include the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant timely submits

a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class(es), in ascending order. The Office will delete the goods/services in the remaining classes not covered by the fees submitted; and

(3) A statement that the applicant still has a bona fide intention to use the mark in commerce, specifying the relevant goods or services, signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (*see* § 2.193(e)(1)). If the verification is unsigned or signed by the wrong party, the applicant must submit a substitute verification within six months of the date of issuance of the notice of allowance.

(b) Before the expiration of the previously granted extension of time, the applicant may request further six month extensions of time to file the statement of use by submitting the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant must specify the classes to be abandoned. If the applicant submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within

the set time period, the Office will apply the fees, beginning with the lowest numbered class(es), in ascending order. The Office will delete the remaining goods/services not covered by the fees submitted;

(3) A statement that the applicant still has a bona fide intention to use the mark in commerce, specifying the relevant goods or services, signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (*see* § 2.193(e)(1)). If the verification is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the previously granted extension; and

(4) A showing of good cause, as specified in paragraph (d) of this section.

(c) Extensions of time under paragraph (b) of this section will be granted only in six-month increments and may not aggregate more than 24 months.

(d) The showing of good cause must include a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the relevant goods or services. Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts to use the mark in commerce.

(e)(1) At the time of the filing of a statement of use, or during any time remaining in the existing six-month period in which a statement of use is filed, applicant may file one request, in accordance with paragraph (a) or (b) of this section, for a six-month extension of time for filing a statement of use, provided that the time requested would not extend beyond 36 months from the issuance of the notice of allowance. Thereafter, applicant may not request any further extensions of time.

(2) A request for an extension of time that is filed at the time of the filing of a statement of use, or during any time remaining in the existing six-month period in which a statement of use is

filed, must comply with all the requirements of paragraph (a) of this section, if it is applicant's first extension request, or paragraph (b) of this section, if it is a second or subsequent extension request. However, in a request under paragraph (b) of this section, applicant may satisfy the requirement for a showing of good cause by asserting that applicant believes that it has made valid use of the mark in commerce, as evidenced by the submitted statement of use, but that if the statement of use is found by the Patent and Trademark Office to be fatally defective, applicant will need additional time in which to file a new statement of use.

(f) The goods or services specified in a request for an extension of time for filing a statement of use must conform to those goods or services identified in the notice of allowance. Any goods or services specified in the notice of allowance which are omitted from the identification of goods or services in the request for extension of time will be presumed to be deleted and the applicant may not thereafter request that the deleted goods or services be reinserted in the application. If appropriate, an applicant may specify the goods or services by stating "those goods or services identified in the notice of allowance" or "those goods or services identified in the notice of allowance except \* \* \*" followed by an identification of the goods or services to be deleted.

(g) The applicant will be notified of the grant or denial of a request for an extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88. If, after denial of an extension request, there is time remaining in the existing six-month period for filing a statement of use, applicant may submit a substitute request for extension of time. Otherwise, the only recourse available after denial of a request for an extension of time is a petition to the Director in accordance with § 2.66 or § 2.146. A petition from the denial of an extension request

must be filed within two months of the date of issuance of the denial of the request. If the petition is granted, the term of the requested six-month extension that was the subject of the petition will run from the date of expiration of the previously existing six-month period for filing a statement of use.

(h) If the extension request is not filed within a reasonable time after it is signed, the Office may require a substitute verification or declaration under § 2.20 stating that the applicant still has a bona fide intention to use the mark in commerce.

[54 FR 37595, Sept. 11, 1989, as amended at 64 FR 48923, Sept. 8, 1999; 64 FR 51245, Sept. 22, 1999; 73 FR 67772, Nov. 17, 2008; 74 FR 54908, Oct. 26, 2009]

EFFECTIVE DATE NOTE: At 80 FR 33186, June 11, 2015, § 2.89 was revised, effective July 11, 2015. For the convenience of the user, the revised text is set forth as follows:

**§ 2.89 Extensions of time for filing a statement of use.**

(a) *First extension request after issuance of notice of allowance.* The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the date of issuance of the notice of allowance under section 13(b)(2) of the Act and must include the following:

(1) A written request for an extension of time to file the statement of use;

(2) The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class, in ascending order. The Office will delete the class(es) not covered by the fees submitted; and

(3) A verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying the relevant goods or services, for trademarks or

service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, specifying the relevant goods, services, or collective membership organization, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement within six months of the date of issuance of the notice of allowance.

(b) *Subsequent extension requests.* Before the expiration of the previously granted extension of time, the applicant may request further six-month extensions of time to file the statement of use by submitting the following:

(1) A written request for an extension of time to file the statement of use;

(2) The requirements of paragraph (a)(2) of this section for a fee;

(3) A verified statement that the applicant has a continued bona fide intention to use the mark in commerce, specifying the relevant goods or services, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, specifying the relevant goods, services, or collective membership organization, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement before the expiration of the previously granted extension; and

(4) A showing of good cause, as specified in paragraph (d) of this section.

(c) *Four subsequent extension requests permitted.* Extension requests specified in paragraph (b) of this section will be granted only in six-month increments and may not aggregate more than 24 months total.

(d) *Good cause.* A showing of good cause must include:

(1) For a trademark or service mark, a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the relevant goods or services. Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts to use the mark in commerce.

(2) For a collective mark, a statement of ongoing efforts to make use of the mark in commerce by members on or in connection with each of the relevant goods or services or in connection with the applicant's collective membership organization. Those efforts may include the development of standards, the steps taken to acquire members such as mar-

keting and promotional activities targeted to potential members, training members regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's members to use the mark in commerce.

(3) For a certification mark, a statement of ongoing efforts to make use of the mark in commerce by authorized users on or in connection with each of the relevant goods or services. Those efforts may include the development of certification standards, steps taken to obtain governmental approval or acquire authorized users, marketing and promoting the recognition of the certification program or of the goods or services that meet the certification standards of the applicant, training authorized users regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's authorized users to use the mark in commerce.

(e) *Extension request filed in conjunction with or after a statement of use.* (1) An applicant may file one request for a six-month extension of time for filing a statement of use when filing a statement of use or after filing a statement of use if time remains in the existing six-month period in which the statement of use was filed, provided that the time requested would not extend beyond 36 months from the date of issuance of the notice of allowance. Thereafter, applicant may not request any further extensions of time.

(2) A request for an extension of time that is filed under paragraph (e)(1) of this section, must comply with all the requirements of paragraph (a) of this section, if it is an applicant's first extension request, or paragraph (b) of this section, if it is a second or subsequent extension request. However, in a request under paragraph (b) of this section, an applicant may satisfy the requirement for a showing of good cause by asserting the applicant believes the applicant has made valid use of the mark in commerce, as evidenced by the submitted statement of use, but that if the statement of use is found by the Office to be fatally defective, the applicant will need additional time in which to file a new statement of use.

(f) *Goods or services.* For trademark, service mark, collective trademark, collective service mark, or certification mark applications, the goods or services specified in a request for an extension of time for filing a statement of use must conform to those goods or services specified in the notice of allowance. Any goods or services specified in the notice of allowance that are omitted from the identification of goods or services in the request for extension of time will be presumed to be deleted and the deleted goods or services may not thereafter be reinserted in the application. For collective membership mark

applications, the description of the nature of the collective membership organization in the request for extension of time must conform to that set forth in the notice of allowance.

(g) *Notice of grant or denial.* The applicant will be notified of the grant or denial of a request for an extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88. If, after denial of an extension request, there is time remaining in the existing six-month period for filing a statement of use, applicant may submit a substitute request for extension of time to correct the defects of the prior request. Otherwise, the only recourse available after denial of a request for an extension of time is to file a petition to the Director in accordance with § 2.66 or § 2.146. A petition from the denial of an extension request must be filed within two months of the date of issuance of the denial of the request. If the petition is granted, the term of the requested six-month extension that was the subject of the petition will run from the date of expiration of the previously existing six-month period for filing a statement of use.

(h) *Verification not filed within reasonable time.* If the verified statement in paragraph (a)(3) or (b)(3) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that the applicant has a continued bona fide intention to use the mark in commerce, for trademarks or service marks; or that the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks or certification marks.

#### INTERFERENCES AND CONCURRENT USE PROCEEDINGS

AUTHORITY: Secs. 2.91 to 2.99 also issued under secs. 16, 17, 60 Stat. 434; 15 U.S.C. 1066, 1067.

#### § 2.91 Declaration of interference.

(a) An interference will not be declared between two applications or between an application and a registration except upon petition to the Director. Interferences will be declared by the Director only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation

proceeding to the party will be deemed to remove any undue prejudice.

(b) Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.

[37 FR 2881, Feb. 9, 1972, as amended at 54 FR 34897, Aug. 22, 1989]

#### § 2.92 Preliminary to interference.

An interference which has been declared by the Director will not be instituted by the Trademark Trial and Appeal Board until the Examiner of Trademarks has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the *Official Gazette* for opposition.

[54 FR 34897, Aug. 22, 1989]

#### § 2.93 Institution of interference.

An interference is instituted by the issuance of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.

[73 FR 67772, Nov. 17, 2008]

#### §§ 2.94–2.95 [Reserved]

#### § 2.96 Issue; burden of proof.

The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof. When there are more than two parties to an interference, a party shall be a junior party to and